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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/098,634	03/13/2002	Geoff S. Chalmers	18360/236825	3718

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EXAMINER

ZURITA, JAMES H

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 10/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/098,634

Applicant(s)

CHALMERS ET AL.

Examiner

James H. Zurita

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-64 is/are pending in the application.
- 4a) Of the above claim(s) 2-10 and 13-64 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 11 and 12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Prosecution History

The following is presented to clarify the record.

On 13 March 2002, applicant filed the instant application, claiming priority to provisional application 60/275861, filed on 14 March 2001.

On 17 October 2002, the application was published as PG-PUB 20020152093.

On 6 April 2005, the Examiner issued a restriction/election requirement.

On 1 July 2005, applicant elected claims 1, 11 and 12.

On 23 September 2005, the Examiner issued a non-final rejection.

On 21 December 2005, applicant amended claims 1 and 11.

On 30 December 2005, the Office issued a Notice of Non-Compliant Amendment under 37 CFR 1.121.

On 25 January 2006, applicant corrected the amendment.

On 31 March 2006, the Examiner issued a final rejection of claims 1, 11 and 12.

On 29 June 2006, applicant requested continued examination (RCE).

Response to Amendment

Applicant's submission of 29 June 2006 has been entered. Applicant amended claims 1 and 11.

Claims 1-64 are pending. Claims 2-10 and 13-64 are withdrawn from consideration by restriction. Claims 1, 11-12 will be examined.

Response to Arguments

Applicant's arguments filed 25 January 2006 have been fully considered but they are not persuasive.

Applicant argues that the term "shipping label" is not indefinite, cites "...multi-functional..." aspects and states that the label

...not only facilitates return of goods from a customer to a merchant, but also, due to its inclusion of a unique package tracking identifier, enables any party to the return transaction (e.g., customer, merchant, carrier) to keep track of shipment status of the returned.

In response to these arguments, the Examiner notes that "...multi-functional..." is not in the claims. The Examiner also respectfully directs applicant's attention to "...track [v.]..." in Hauser, as in Col. 2, lines 49-67, Col. 3, line 65-Col. 4, line 14.

In response to applicant's arguments concerning the rejection under 35 USC 112 second paragraph, the Examiner notes that applicant's comments do not appear to address the issue raised, in that applicant mentions several labels and it is not clear what applicant claims.

Examiner cites particular columns and line numbers in the references as applied to the claims for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Claim Rejections - 35 USC § 112

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Please note that these rejections are necessitated by applicant's comments, since it appears that applicant claims patentability based on the specific format of a label and its contents. The claims refer to shipping label. Applicant refers to various labels, including Fig. 6, item 400 (RETURN SHIPPING LABEL and RETURN SERVICE LABEL, as in paragraph 78).

For purposes of examination, the term shipping label will be given its broadest reasonable interpretation as referring to a return authorization shipping label.

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1 and 11 are rejected under 35 U.S.C. 102(e) as being anticipated by Hauser et al. (US 6,536,659).

As per claim 1, Hauser discloses method(s) of electronically providing a shipping label to a customer that wishes to return a good that was previously purchased from a merchant, said method comprising the steps of

initiating a return transaction upon receipt of a return service request, wherein said return service request contains shipping information, said shipping information comprising an address of said customer and an address of said merchant (see, for example, at least Fig. 1, item 12, Col. 3, lines 43-63, Col. 3, line 65-Col. 4, line 15, Fig. 1, items 20-24);

assigning a package tracking identifier to said return transaction, wherein said package tracking identifier is readable by a carrier shipment tracking system for tracking shipment of said good to be returned (See, for example, at least Col. 2, lines 49-67, Col. 3, line 65-Col. 4, line 15, see also references Return Merchandise Authorization number, as in Col.3, lines 43-64, other references to tracking, as in Col. 3, line 65-Col. 4, line 14);

generating said shipping label based at least in part on said shipping information, *said shipping label being acceptable by said carrier to deliver said good to said merchant according to said return transaction and* including said package tracking identifier for tracking shipment of said good during return delivery to said merchant Col. 3, lines 43-64);

providing said shipping label to said customer in electronic form (see, for example, at least Col. 4, lines 16-35, Col. 8, lines 45-54, email attachment).

As per claim 11, Hauser discloses that providing said shipping label to said customer in electronic form, comprises the steps of

storing an electronic image of said shipping label (see, for example, at least Fig. 1, item 18 and related text);

sending to said customer a *label delivery* link through which said customer obtain access to said electronic image (see, for example, at least Col. 8, lines 45-54, the email has a link to an attached document; the link is used to deliver the label to be used for shipping).

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hauser in view of Caminiti, Alan, Lyons, Cheryl, United Parcel Service Introduces Advanced Label Imaging System, published by Business Wire on 29 November 1989, sec. 1, page 1, downloaded from the Internet on 19 September 2005.

As per claim 12, Hauser does not specifically disclose that the electronic image of a shipping label is stored on a carrier server. This feature is disclosed by Caminiti, which stores images of shipping labels on the server of a carrier like UPS. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Hauser and Caminiti to disclose that an electronic image of a shipping label is stored on a carrier server.

One of ordinary skill in the art at the time the invention was made would have been motivated to combine Hauser and Caminiti to disclose that an electronic image of a shipping label is stored on a carrier server for the obvious reason that customer

service representatives and shippers using a carrier's network may be better equipped to respond quickly and accurately to package inquiries.

Conclusion

An issue of public use or on sale activity has been raised in this application. In order for the examiner to properly consider patentability of the claimed invention under 35 U.S.C. 102(b), additional information regarding this issue is required as follows:

Please provide materials prior to 14 March 2000 concerning UPS "Returns on the Web" product, including, but not limited to:

Versions prior to 1.0.6, dated 02/13/01

Revisions of XML OnLine Tools, Returns on the Web, IMT 300 Architecture.

Versions prior to version 000927.01, copyright 2000.

Applicant is reminded that failure to fully reply to this requirement for information will result in a holding of abandonment.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H. Zurita whose telephone number is 571-272-6766. The examiner can normally be reached on 8a-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

James Zurita
Primary Examiner
Art Unit 3625
30 September 2006

James Zurita
Primary Examiner